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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/589,497	08/15/2006	Isao Miyagawa	0033-1091PUS1	9861
2292 7590 06/15/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
JANSSEN, SHANNON L.				
ART UNIT		PAPER NUMBER		
1639				
NOTIFICATION DATE		DELIVERY MODE		
06/15/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

***Advisory Action Continued***

The amendment filed May 24, 2010 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because of the following:

a. The proposed amendment requires further consideration and/or search (e.g. the new limitation “wherein a difference in a vapor pressure between the vessel solution and the solution comprising the sample biopolymer is the difference in the vapor pressure produced as a difference in molar concentration ranging from - 10% to +8% between solutes in the vessel solution and the solution comprising the sample biopolymer” of claim 1, since the limitation of “the same solute molar concentration” was not in the claims prior to amendment).

b. The proposed amendment may necessitate the modification of outstanding rejection(s) to address the new limitation (e.g. the new limitation “wherein a difference in a vapor pressure between the vessel solution and the solution comprising the sample biopolymer is the difference in the vapor pressure produced as a difference in molar concentration ranging from - 10% to +8% between solutes in the vessel solution and the solution comprising the sample biopolymer”).

c. The proposed amendment may necessitate the raising of new prior art rejections (e.g. the new limitation “wherein a difference in a vapor pressure between the vessel solution and the solution comprising the sample biopolymer is the difference in the vapor pressure produced as a difference in molar concentration ranging from - 10% to +8% between solutes in the vessel solution and the solution comprising the sample biopolymer”).

d. The proposed amendment may necessitate the raising of new 112 issues (e.g. the new limitation “wherein a difference in a vapor pressure between the vessel solution and the solution comprising the sample biopolymer is the difference in the vapor pressure produced as a difference in molar concentration ranging from - 10% to +8% between solutes in the vessel solution and the solution comprising the sample biopolymer”).

e. There is no convincing evidence under 37 CFR 1.116(b) why the proposed amendment was not earlier presented.

f. Applicants arguments of the prior art of record are moot since the arguments are based on the proposed amendments that have not been entered.

g. For all the reasons above, the amendment does not place the application in better condition for allowance and/or appeal.

#### **Response to Arguments**

Applicant's arguments filed May 24, 2010 have been fully considered but they are not persuasive for the following reasons.

Applicants assert that “the same vapor pressure” means “that the difference between the molar concentration of the solute contained in the solution containing the sample biopolymer and the molar concentration of the solute contained in the humectant [vessel solution] is -10 to +8%” (Remarks, page 4). However, the definition provided is directed to “the same solute molar concentration” (Specification, page 6, lines 18-22), which was not previously in the claims. In addition, the limitation inserted in the claims is not the same as the definition provided in the specification (e.g.: the specification does not address differences in vapor pressure).

Applicants also assert that the differences in the range cited are critical to the invention. However, the instant claims are directed to a hybridization method; Applicants have not demonstrated that hybridization does not occur with differences in concentration outside of the cited range. Applicants have not demonstrated that the cited range is critical to hybridization. The specification teaches changes in volume of the hybridization solution, but does not teach that hybridization does not occur due to these changes. Applicants assert that "hybridization cannot proceed normally" (Remarks, page 6) at a difference of 20%, however it is not clear what constitutes "normal" hybridization (e.g.: is there a difference in the amount of hybridization?). The specification does not teach that the cited range is critical for hybridization to occur. The specification appears to be directed to *optimal* conditions for hybridization rather than *critical* conditions.

"Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (Claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70% was held to be prima facie obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100°C and an acid concentration of 10%.); see also Peterson, 315 F.3d at 1330, 65 USPQ2d at 1382 ("The normal desire of scientists or artisans to improve upon what is already

generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages.”)” See MPEP § 2144.05 II.

***Future Communications***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANNON JANSSEN whose telephone number is (571)270-1303. The examiner can normally be reached on Monday-Friday 10:00AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amber D. Steele/  
Primary Examiner, Art Unit 1639

Shannon L Janssen